

REMARKS

Reconsideration of this application, in view of the following remarks, is respectfully requested.

Claims 1-16 and 24-35 are currently pending in this application and stand rejected on the following grounds which are respectfully traversed for reasons subsequently set forth herein.

1. Claims 1-16 and 24-35 stand rejected under 35 USC §101;
2. Claims 1-16 and 24-35 stand rejected under 35 USC §112, second paragraph, as being indefinite;
3. Claims 1, 2, 4, 5 and 24-26 stand rejected under 35 USC §102(e) as being anticipated by U.S. Patent 6,457,525 to Scott; and
4. Claims 1-5, 10, 14, 24-26, 31, 34 and 35 stand rejected under 35 USC §102(e) as being anticipated by U.S. Patent 6,311,776 to Pringle et al.

The Examiner's rejections of Claims 1-16 and 24-35 under 35 USC §101 and §112 are based on the Examiner's contention that each of the claims sets forth both apparatus and method limitations. As an example, the Examiner points to independent Claim 1, an apparatus claim which recites a production wellbore extending into the formation and **withdrawing** gas from the formation and a storage wellbore extending into the formation and **injecting** gas into the formation (see FIG. 5). The Examiner is characterizing the words "withdrawing" and "injecting" as **method** limitations which render the apparatus claim both nonstatutory under 35 USC §101 and indefinite under 35 USC §112. Similar §101 and §112 rejections are made to independent Claim 24, and the Examiner further points to allegedly improper mixtures of apparatus and method limitations in dependent Claims 2-16 and 25-35.

These 35 USC §101 and §112 rejections are clearly improper and should be withdrawn. There is nothing in the patent statutes or rules which prevents the recitation that an apparatus claim element is actually **doing something** (for example, that a recited production wellbore is **withdrawing** gas from a formation). If this were the case, then an apparatus claim specifying, for example, "a first board, a second board, and a nail **holding** the first and second boards together" would be both nonstatutory and indefinite under to the Examiner's reasoning. This is clearly not the case, and thus the recitation in the present applicant's independent Claims 1 and 24 that a production wellbore is **withdrawing** gas from a formation and a storage wellbore is **injecting** gas into the formation is both statutory and definite. Similar functional recitations in various ones of applicant's dependent Claims 2-16 and 25-35 are also proper apparatus limitations in apparatus claims, and are neither nonstatutory nor indefinite in any manner.

As a part of his indefiniteness rejection of Claims 1-16 and 25-36, the Examiner states that:

Further, it is not clear as to how the "production wellbore" [withdraws] gas from the formation" nor, particularly, how the "storage wellbore" [injects] gas into the formation". And, it is not clear as to how the "production wellbore" is "withdrawing gas from the formation" at the same time the "storage wellbore" is "injecting gas into the formation". Also, it is not clear as to how the "gas [is] being withdrawn from the formation into the main wellbore via the production wellbore".

In this regard the Examiner's attention is respectfully directed to applicant's specification, beginning on line 1 of page 14 thereof, wherein it is stated, with reference to FIG. 4, that:

A tubing string 64 having a seal assembly 66 proximate a lower end thereof is installed in the main wellbore 12. The seal assembly 66 is stabbed into the packer 28 or an associated seal bore extension. The tubing string 64 now provides a conduit for injecting gas from the earth's surface, into the sand control assembly 26 in the storage wellbore 24, and outward into the formation 14. The direction of gas flow is indicated by the arrow 68.

Another conduit for gas flow is provided by an annulus 70 formed between the tubing string 64 and the wellbore 12. Gas is received into the annulus 70 from the sand control assembly 46, which in turn receives the gas from the formation 14. The gas may be flowed to the earth's surface in the annulus 70, in the direction indicated by arrows 72.

This is seen to clearly describe the production wellbore's withdrawal of gas from the formation and the storage wellbore's injection of gas into the formation.

For the foregoing reasons it is submitted that all of applicant's Claims 1-16 and 24-36 are both statutory and definite. It is thus respectfully requested that the Examiner's 35 USC §101 and §112 rejections of Claims 1-16 and 24-36 be withdrawn.

Turning now to the merits of applicant's claims, via independent Claim 1 each of applicant's Claims 1-16 specifies a production wellbore extending into a recited formation and withdrawing gas therefrom, and a storage wellbore extending into the formation and injecting gas from the formation, the production and storage wellbores intersecting at a wellbore junction. Via independent Claim 24, each of applicant's Claims 24-36 specifies a gas storage and production system comprising a main wellbore extending from the earth's surface to a wellbore junction; a storage wellbore extending from the main wellbore into a gas storage formation; and a production wellbore extending from the main wellbore

into the formation via the storage wellbore, and gas being withdrawn from the formation into the main wellbore via the production wellbore.

Neither Scott nor Pringle et al discloses intersecting wellbores, with one of the wellbores injecting gas into a formation, and the other wellbore withdrawing gas from the formation. Additionally, neither Scott nor Pringle discloses a main wellbore extending from the earth's surface to a wellbore junction; a storage wellbore extending from the main wellbore into a gas storage formation; and a production wellbore extending from the main wellbore into the formation, with gas being injected from the main wellbore into the formation via the storage wellbore, and gas being withdrawn from the formation into the main wellbore via the production wellbore. Instead, each of the Scott and Pringle et al references illustrated and describes drilling multiple wellbores into a formation in order to better produce hydrocarbons from the formation.

As can readily be seen, the Examiner is considering only structural limitations in applicant's claims and is totally ignoring the functional limitations in these claims which relate to the **withdrawal** and **injection** of gas via intersecting production and storage wellbores. Neither of the Scott and Pringle et al references discloses apparatus performing this claimed gas withdrawal and injection.

It is thus respectfully submitted that none of applicant's Claims 1, 2, 4, 5 and 24-26 is anticipated by the Scott reference, and none of applicant's Claims 1-5, 10, 14, 24-26, 31, 34 and 35 is anticipated by the Pringle et al reference.

In view of the foregoing amendment and remarks, all of the claims currently pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of Claims 1-16 and 24-36 is therefore earnestly solicited. In conjunction with the issuance of such Notice of Allowance, the Examiner is hereby authorized to cancel the temporarily withdrawn Claims 17-23, without prejudice to or disclaimer by the applicant, by Examiner's Amendment.

The Examiner is hereby requested to telephone the undersigned attorney of record at 972/516-0030 if such would further or expedite the prosecution of the instant application.

Respectfully submitted,

KONNEKER & SMITH, P.C.



J. Richard Konneker
Attorney for Applicant
Registration No. 28,867

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660 N. Central Expwy., #230
Plano, Texas 75074
972/516-0030

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450,

on June 24, 2003
Diane Sutton